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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,190	03/29/2001	Martin A. Kenncr	56096US002	4518
32692	7590	07/26/2006	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			OSMAN, RAMY M	
PO BOX 33427			ART UNIT	
ST. PAUL, MN 55133-3427			PAPER NUMBER	

2157

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/821,190	<b>Applicant(s)</b> KENNER ET AL.	
	<b>Examiner</b> Ramy M. Osman	<b>Art Unit</b> 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 12-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

1. This communication is in response to appeal brief filed 5/15/2006 which subsequently followed amendment filed on 9/8/2005, in which applicant amended claims 1,9,12,13,18,20,32, 36-40, cancelled claims 10,11, and added new claims 43,44 and 45. Claims 1-9,12-45 are pending.

### ***Claim Objections***

2. Claim 1 objected to because of the following informalities: On line 14 change “display notice” to “display a notice”. Appropriate correction is required.

### ***Response to Arguments***

3. Applicant's arguments filed 5/15/2006 with respect to claims 1-45 have been considered but are moot in view of the new ground(s) of rejection.

4. In regards to 112 first paragraph rejection of claims 5,27 and 35, in the arguments filed 5/15/2006 applicant argues that *1) a website cannot identify a user that downloads content from it unless the user happens to give an identifier to the website; and 2) assuming a user has not opened a communication link with website and assuming web site does not have identifier, the website cannot communicate with user.*

**In reply to 1),** applicants argument is false because the Internet is based on TCP/IP protocols in which communication is based on source and destination IP addresses. For a client

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(source device) to send a 'request for content' to a server (destination device), the client sends a request packet to the server. The request packet has an IP header which contains the source IP address (of the client) and the destination IP address (of the server). When the server receives this request, the server can identify the source IP address of the client. Therefore it is seen that a website can identify a user that downloads content from it.

Applicants specification is silent as to how to anonymize a user downloading content from a website.

5. **In reply to 2)**, applicant is making two assumptions that are not mentioned in the claims and were not disclosed in the specification. Assumptions are not read into the claims.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 5,27,35 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant states that the method "is performed without identifying the content recipient to the content provider". The specification merely repeats this language on page 29 lines 5-10, and fails to further explain how a client can request something without identifying itself. A client request inherently involves some sort of identification so that the provider can respond and send

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information back to the client. Internet request packets include source and destination IP address fields. It is therefore seen that the source (i.e. content recipient) is identified, and the provider uses that identifier to respond to the recipient. To anonymize this identification, a method or protocol is necessary to accomplish it. Applicant fails to detail this feature.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 1-9,18,19,21,26-35 and 40-45 rejected under 35 U.S.C. 102(b) as being anticipated by Apfel et al (US Patent No 5,974,454).**

10. ***In reference to independent claim 1***, Apfel teaches a method performed at a content recipient, and a computer readable storage comprising:

executing first program code at the content recipient so as to identify a content provider having posted content of interest to the content recipient (column 6 lines 40-45);

executing second program code at the content recipient so as to automatically initiate a request for the posted content (column 7 lines 1-7);

executing third program code at the content recipient so as to receive the posted content at the content recipient in response to execution of the second program code (column 7 lines 5-10); and

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executing fourth program code at the content recipient so as to provide a notice to the content recipient that the posted content has been received at the content recipient in response to execution of the second and third program code (column 10 lines 5-25 & 48-67 and column 11 lines 1-10).

11. ***In reference to independent claim 18***, Apfel teaches a computer readable medium, storing code, when executed by a computing device, performs the following functions:

automatically initiating a request for the download of a content element of a web page posted by a content provider (column 2 lines 15-40); and

receiving only the content element in response to the request without receiving the whole web page (column 5 line 60 – column 6 line 5).

12. ***In reference to independent claim 32***, Apfel teaches a method comprising:

executing first program code at content provider so as to post content for access by a content recipient (column 5 line 60 – column 6 line 5);

executing second program code at content recipient so as to automatically (i) access the content provider and (ii) initiate receipt by the content recipient of the posted content if the posted content is new (column 6 line 63 – column 7 line 10); and

executing third program code at the content provider so as to send a message notifying the content recipient that the posted content is not new (column 9 lines 40-50).

13. ***In reference to independent claim 45***, Apfel teaches a method comprising:

executing first program code at content recipient so as to identify a content provider having posted content of interest to the recipient (column 6 lines 40-45);

executing second program code at content recipient so as to automatically initiate a request for the posted content (column 7 lines 1-7); and

executing third program code at the content recipient so as to receive a notice that the content provider has no new content to download to the content recipient (column 9 lines 40-50).

*As for the dependent claims:*

14. In reference to claim 2,4,6,8 and 33, Apfel teaches the method and computer readable storage of claims 1 and 32 further comprising canceling future requests for the posted content without communicating such an intent to the content provider (column 8 lines 30-36).

15. In reference to claim 3,7 and 34, Apfel teaches the method and computer readable storage of claims 1,18 and 32 wherein the executing of the second program code at the content recipient so as to automatically initiate a request for the posted content comprises executing second program code at the content recipient so as to automatically and recurrently initiate requests for the posted content (column 8 lines 22-33 and column 9 lines 15-26 & 50-65).

16. In reference to claims 5,27 and 35, Apfel teaches the method and computer readable storage of claims 1,18 and 32, wherein the method is performed without identifying the content recipient to the content provider (column 5 lines 1-25).

17. In reference to claim 9, Apfel teaches the method of claim 1 further comprising executing fifth program code at the recipient so as to provide notice to the content recipient that no posted content has been received by the content recipient in response to execution of the second program code (column 9 lines 40-50).

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18. In reference to claims 17, 41 and 42, Apfel teaches the method and computer readable storage of claims 1 and 32, electronically receiving the second program code at the content recipient from the content provider (column 6 line 63 – column 7 line 10).

19. In reference to claims 19,21, Apfel teaches the computer readable storage medium of claim 18, wherein the code provides notice that the posted content has been received in response to the request (column 11 lines 1-10).

20. In reference to claims 26,28 Apfel teaches the computer readable storage of claim 18, wherein the stored code when executed, automatically and recurrently initiate requests for the posted content (column 8 lines 22-33 and column 9 lines 15-26 & 50-65).

21. In reference to claim 29, Apfel teaches the method and computer readable storage of claim 18, providing notice that no posted content has been received in response to the request (column 9 lines 40-50).

22. In reference to claims 30 and 31, Apfel teaches the computer of claim 18 wherein the stored program code is electronically received from the content provider and is stored by the computer readable storage medium (column 6 line 63 – column 7 line 10).

23. In reference to claim 40, Apfel teaches the method of claim 32 further comprising executing third program code at the content provider so as to determine whether the content recipient possesses the second program code and, if the content recipient does not possess the second program code, to download the second program code to the content recipient (column 6 line 35 – column 7 line 30).



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24. In reference to claim 43, Apfel teaches the method of claim 1, further comprising executing fifth program code at the content recipient so that, upon an action related to the notice, the posted content is displayed to a user (column 7 lines 40-55 and column 11 lines 1-10).

25. In reference to claim 44, Apfel teaches the method and computer readable storage of claim 18, wherein the content element comprises a note attached to the web page (column 2 lines 15-60).

***Claim Rejections - 35 USC § 103***

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. **Claims 12,13,15,16,20,22,24,25,28,36,37,39 rejected under 35 U.S.C. 103(a) as being unpatentable over Apfel et al (US Patent No 5,974,454) in view of Stephens (US Patent No 6,557,026).**

28. In reference to claims 12,20,22 and 36, Apfel teaches the method and computer of claims 1. Apfel fails to teach wherein executing third program code so that the posted content, when received, is displayed behind a session if the session is active. However, Stephens teaches where information can be viewed on a computer by the use of overlaying windows in front of each other. Stephens discloses outputting a window to a display even though the window will not be visible to a user where the user can later be alerted of its presence (Stephens, column 6 lines 20-35 and column 7 lines 35-40 & 50-60).

It would have been obvious for one of ordinary skill in the art to modify to display a window (i.e the posted content) behind an active window as per the teachings of Stephens so as to later be alerted of its presence.

29. In reference to claims 13 and 37, Apfel in view of Stephens teach the method and computer readable storage of claims 12 and 36, wherein the executing of the fourth program code at the content recipient comprises executing the fourth code so as to display the notice even if the session is active (Stephens, column 6 lines 20-35 and column 7 lines 35-40 & 50-60).

30. In reference to claims 15,16,28 and 39, Apfel in view of Stephens teach the method and computer readable storage of claims 13 and 37 above. Apfel fails to explicitly teach wherein the method further comprises executing fifth program code at the content recipient so that, upon an action related to the notice, the posted content burns through the session so that the posted content is visible to a user; and comprises executing fifth program code at the content recipient so that, upon an action related to the notice, the posted content is displayed in front of the session so that the posted content is visible to a user. However, Stephens teaches overlaying windows for multiple active programs. Stephens discloses bringing a window layer to the front of all other layers so that the layer can then be visible to a user (Stephens, column 6 lines 20-35 and column 7 lines 35-40 & 50-60).

It would have been obvious for one of ordinary skill in the art to modify to display a window (i.e the posted content) in front of an active window as per the teachings of Stephens so as to be alerted of its presence.

31. In reference to claims 24 and 25, Apfel teaches the computer readable storage of claim 18 above. Apfel fails to explicitly teach burning the posted content the posted content through a

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session so that the posted content is visible to a user; and displaying the posted content in front of the session so that the posted content is visible to a user. However, Stephens teaches overlaying windows for multiple active programs. Stephens discloses bringing a window layer to the front of all other layers so that the layer can then be visible to a user (column 2 lines 3-11 & 53-67 and column 10 lines 20-67).

It would have been obvious for one of ordinary skill in the art to modify to display a window (i.e the posted content) in front of an active window as per the teachings of Stephens so as to be alerted of its presence.

**32. Claim 14,23 rejected under 35 U.S.C. 103(a) as being unpatentable over Apfel et al (US Patent No 5,974,454) in view of Stephens (US Patent No 6,557,026) in further view of Beyda et al (US Patent No 6,636,965).**

Apfel teaches the method of claims 14 and 23. Apfel fails to explicitly teach wherein the notice is an icon. However, Beyda teaches recipients receiving electronic messages. Beyda discloses icons accompanying the messages for the purpose of alerting users of the message (Abstract and column 4 lines 10-20).

It would have been obvious for one of ordinary skill in the art to modify Apfel by making the notice an icon as per the teachings of Beyda complete messages for the purpose of alerting users of the message.

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33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramy M. Osman whose telephone number is (571) 272-4008. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RMO  
July 21, 2006

  
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